REMARKS

Applicant wishes to thank the Examiner for reviewing the present application.

1. Amendments to the Claims

Claims 14 and 24 are amended to clarify that the negotiation process recited in these claims is a categorization negotiation. That the negotiation process recited in these two claims is to negotiate a category is clear in the claims themselves. For example, in claim 14, it is recited that the sender subsystem is configured to identify a category, to initiate a categorization process and then to associate the negotiated category with the outgoing message. It would be clear to one skilled in the art from the preparation required for the negotiation and the output of the negotiation that the negotiation is to agree on a category, or a categorization negotiation. Similarly, in claim 24, it is recited that the negotiation module includes a sender subsystem for initiating a negotiation of a category and further that the sender subsystem is configured to identify a category, to initiate a categorization negotiation and to associate the negotiated category with the outgoing message. Independent claims 37, 47 and 52 also recite in various details the steps of a negotiation process to agree on a category. It would be clear to one skilled in the art that the negotiation is negotiation of a category.

That the negotiation is the negotiation of a category is also amply supported by the disclosure. For example, Applicant discusses in paragraph 26 that the sender of a message has the increased responsibility to categorize information being sent (e.g., to associate a category with a message). Applicant then discusses in paragraph 33 that sender, through the sender subsystem, must first negotiate the categorization of the message with the receiver subsystem. Further examples are provided in figures and their description to illustrate the categorization negotiation process and the subsequent categorization of message by the sender subsystem (see, for example, Figures 2 and 9).

In the Examiner's discussion of prior art references and claims, the Examiner also treated the negotiation as negotiation of a category. For example, the Examiner indicated that claims 37 and 52 "do not teach of further define over the limitations of claim 14" and simply rejected claims 37 and 52 "for at least the same reasons set forth for claim 14." As indicated above, claim 14 recites initiating a negotiation process by the sender. Claim 37 recites the steps in a negotiation process that includes identifying a category, communicating the category to the

receiver subsystem, which subsequently indicates to the sender subsystem of its recognition of the category. Claim 52 also includes the claim limitation of causing the sender subsystem to initiate negotiation with the receiver system to agree on a category. The negotiation process recited in these claims is to negotiate a category. Similarly, in rejecting claim 24 which recites a negotiation process, the Examiner cited paragraph 26 in Schiavone as an example to show that Schiavone teaches negotiation of a category.

It is respectfully submitted that the proposed amendments merely serve to clarify claims 14 and 24. That the negotiation is to negotiate a category can be ascertained from the claims themselves, is amply supported by the disclosure and was also the Examiner's interpretation of the term. Such clarification helps to place the application in a better position for allowance. The entry of the amendments is respectfully requested.

2. Claim Rejections under 35 USC §112

The Examiner rejected claims 14-56 under 35 USC §112 for failing to comply with the written description requirement. The Examiner indicated that the claims contained subject matter not described in the Applicant's specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention. The Examiner specifically identified a claimed feature that the negotiation process includes a sender system associating a category with a message upon receiving an indication from the receiver that the receiver recognizes the category.

In Applicant's specification, Applicant discusses in paragraph 26 that the sender of a message has the increased responsibility to categorize information being sent (e.g., to associate a category with a message). The reason for this increased responsibility, according to the inventor, is that, at the time the communication is initiated, the sender has more information about the context than the receiver. However, the sender does not act alone to categorize the message. Applicant discloses that when categorizing the communication (or message), the sender unifies both the sender's and the receiver's preferences for categorization. One skilled in the art would therefore reasonably infer that the sender takes into account information from the receiver when categorizing a message.

Applicant further discusses in paragraph 33 that sender, through the sender subsystem, must first negotiate the categorization of the message with the receiver subsystem. In other words, the information from the receiver is feedback received in the negotiation from the

receiver subsystem (which negotiates on behalf of the receiver). It is further disclosed in this paragraph that the feedback from the receiver subsystem is that the category is one that is recognized or accepted by the receiver (described as being recognized and accepted by both the receiver subsystem and sender system, i.e., a "common ground" reached by these two subsystems).

Further examples of such a negotiation process and the subsequent categorization of message by the sender subsystem also can be found in the description in connection with the figures. For example, in reference to Fig. 2, Applicant describes that the sender subsystem initiates a negotiation process and communicates with the receiver subsystem to negotiate and determine a category at the time of composing a message. Upon a user entering more information, the sender subsystem may use additional information to start negotiating a new category with the receiver subsystem. In reference to Fig. 9, Applicant describes in paragraph 42 some examples of selecting a proposed category by the sender subsystem which it then negotiates with the receiver subsystem to agree on the category.

Accordingly, it is respectfully submitted that Applicant's specification does describe in sufficient detail a negotiation and categorization process as claimed in such a way that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. More particularly, as discussed above, Applicant's specification does describe a negotiation process in which the sender subsystem selects a proposed category, initiates the negotiation process with the receiver subsystem and negotiate the category with the receiver subsystem in order to achieve agreement, or common ground, and then, upon completion of the negotiation, categorize the message with the negotiated category. Accordingly, it is respectfully submitted that claims 14-56 comply with the written description requirement under 35 USC §112. The withdrawal of the Examiner's rejection of claims 14-56 under 35 USC §112 is respectfully requested.

3. Claim Rejections under 35 USC §103(a)

(a) Claims 14-17, 20-43, and 47-56

The Examiner rejected claims 14-17, 20-43 and 47-56 under 35 USC §103(a) as being obvious over Schiavone (U.S. Patent Application Publication No. 2002/0120600), in view of Gross (U.S. Patent Application Publication No. 2002/01204748).

Claims 14, 24, 37, 47 and 52 are independent claims. Claims 15-17, 20-23 depend from claim 14. Claims 25-36 depend from claim 24. Claims 38-43 depend from claim 37. Claims 48-51 depend from claim 47. Claims 53-56 depend from claim 52. Independent claims 14, 24, 37, 47 and 52 will be first considered below.

Applicant notes that independent claims 14, 24, 37, 47 and 52 all recite the negotiation of a category between the sender subsystem and the receiver subsystem and the association of the message with the negotiated category. For example, claim 14 requires, among others, the sender subsystem to initiate a categorization negotiation process with the receiver subsystem, to associate the negotiated category with the message and to transmit such a categorized message to the receiver subsystem. Claim 37 requires a categorization process that requires the sender subsystem to identify a category and communicate the category to the receiver subsystem, and requires the receiver subsystem to provide an indication that it recognizes the category communicated by the sender subsystem, and requires the sender subsystem to associate the category with the outgoing message. Similarly, claim 47 requires, among others, the sender subsystem to identify and then negotiate a category with the receiver subsystem, associate the negotiated category with the outgoing message and then transmit the categorized message to the receiver subsystem. Similar claim limitations, with varying level of detail, are also required by other independent claims.

The Examiner attempts to show in the Office Action that Schiavone teaches a negotiation process and that Gross discloses a sender subsystem associating a category with a message upon receiving an indication that a receiver subsystem recognizes the category. With due respect, it is submitted that the Examiner has incorrectly determined the scope of the teaching in the prior art references. Schiavone and Gross, either alone or in combination, do not contain the teachings as alleged by the Examiner.

The Examiner attempts to show that Schiavone disclosed in paragraph [0051] the negotiation of a category (Office Action, page 4, paragraph 6, and page 11, paragraph 30). Paragraph [0051] of Schiavone is reproduced below in its entirety:

> [0051] In one embodiment, the message is modified by altering, i.e, assigning a value to, recipient dependent variables in the electronic mail message. For example, this may result in a "dynamic offer"--a message that contains that contains [sic] several versions or elements that can be constructed and/or modified based on a predetermined rule set that negotiates the delivery, filtering and form of the offer based on the e-mail message's confidential "sniffing" of the recipient's private profile data 120b (by Compliance engine 154) prior to the delivery to and/or opening of such message by an intended recipient.

Clearly Schiavone does not teach any negotiation of a category or a negotiation initiated by the sender subsystem. Applicant also has studied carefully paragraphs immediately before and after paragraph [0051] and is unable to identify any teaching of negotiation of a category in Schiavone. As Examiner noted, Schiavone does mention the negotiation of delivery of a message. However, negotiation of delivery is not what is recited in Applicant's claims. It is respectfully submitted that delivery of a message is entirely different from a message (or category) that is being delivered. What is not taught in Schiavone is the negotiation of a category, let alone initiating the negotiation by the sender subsystem.

The Examiner also stated, in rejecting claim 47, that Schiavone disclosed in paragraph [0026] a sender subsystem negotiating a category with the receiver subsystem (Office Action, page 8, paragraph 19). However, this is also not correct. Paragraph [0026] of Schiavone does not describe any negotiation performed by a sender subsystem at all. Paragraph [0026] of Schiavone is reproduced below:

> [0026] It is advantageous that the sender and recipient share knowledge of a common set of message type specifiers and that the mail type specifier for a given message is one selected from the common set. For example, the set may be established and/or maintained by a trusted third-party intermediary, i.e. a trusted authority.

This paragraph does not teach a "negotiation", but merely selecting a message type specifier from a common set. The common set, as taught by Schiavone, is established and/or maintained by a trusted third party. In other words, the common set is provided to both the sender and the receiver and that the set is common to both simply because both received the same set from the same source, the trusted third party. There is no teaching at all, either in this paragraph, or anywhere in Schiavone, that a sender subsystem negotiates a category with the recipient subsystem.

That Schiavone does not teach negotiation of a category is to be expected. Schiavone does not contemplate an environment in which a recipient negotiates with a sender. Instead, the system disclosed in Schiavone is a rule-based system ("The present invention provides a system and method for rule-based processing of electronic mail messages. The rules include logic for processing of incoming messages." Schiavone, paragraph [0007]). Establishing these rules allows a sender to specify how its message is to be processed by the recipient, i.e., process it according to a predetermined rule. Allowing negotiation would defeat this purpose. According to Schiavone, in its "Summary of the Invention", at paragraph [0008]:

[0008] Accordingly, the present invention enables an individual user to conduct a complex transaction via e-mail by composing a simple message and specifying processing in compliance with a potentially complex logic-based rule, e.g., a predetermined rule.

Not only that Schiavone does not teach the negotiation of a category, Gross also does not teach the negotiation of a category. Gross is also about processing messages in accordance with pre-established criteria. However, unlike Schiavone, Gross requires a recipient, instead of a sender as in Schiavone, to establish criteria and publish the rules for the senders to follow. Gross teaches that the receivers can publish or broadcast categories and/or processes that a sender must follow, that the receives can set up restrictions on what they will accept, and that receivers can configure rules to process incoming messages based on their published collection of tags. See, for example, paragraphs [0042], [0045] and [0051]-[0057] in Gross. Gross also does not contemplate an environment in which a recipient negotiates with a sender or teach any negotiation of categories. Again, allowing negotiation would defeat the purpose of specifying these pre-established criteria. Applicant notes that the Examiner also did not cite Gross as teaching negotiation of a category.

Accordingly, it is respectfully submitted that Schiavone and Gross, either alone or in combination, do not teach negotiation of a category, let alone the sender subsystem initiating the negotiation.

However, the Examiner did cite Gross as teaching a sender subsystem associating a category with a message upon receiving an indication that a receiver subsystem recognizes the category. It is respectfully submitted that the Examiner was mistaken and that Gross does not contain such teaching as alleged by the Examiner.

In addition to the claim limitation requiring a sender subsystem that initiates a categorization negotiation process with the receiver subsystem, Applicant also recites that the sender subsystem associates the (negotiated) category with the (outgoing) message upon receiving an indication from the receiver subsystem that the category is recognized by the receiver subsystem and subsequently transmits the categorized message to the receiver subsystem.

The Examiner attempts to show that Gross teaches these limitations. In particular, the Examiner stated in the Office Action that Gross in paragraph [0263] teaches that "receiver may accept or reject the proposed category" and in paragraph [0268] that the receiver "sending an

indication to the sender to categorize a message according to newly accepted categories" (Office Action, page 5, lines 2-5). It is respectfully submitted that Gross does not contain these alleged teachings, certainly not the features as recited in Applicant's claims.

Paragraphs [0263] and [0268] of Gross are reproduced below in their entirety:

[0263] It will be appreciated that new processing criteria can be continuously added, deleted, or changed by a recipient or a 3rd party, such as an administrator, on behalf of the recipient. It will also be appreciated that a sender can make suggestions to a receiver--by, for example, means of a message--to add processing criteria not yet known to the receiver, which the receiver can confirm to accept or reject.

. . .

[0268] It will also be appreciated that messages received prior to the splitting of a processing criteria into parts, could be sent back to their senders together with a directive to further categorize the messages in accordance to the new processing criteria introduced by the splitting of the processing criteria into parts.

Clearly, what is described here relates to "processing criteria", not "categories". Gross teaches categorization of messages based on "tags" ("The restricted availability of tags and the selection of tags by a sender enables messages to be appropriately categorized and hence appropriately processed," paragraph [0044]; "when composing a message that is categorized with said tags", paragraph [0049], Gross.) But tags are different from processing criteria and are treated as different things by Gross. For example, in paragraph [0045], Gross teaches that

[0045] Although in the above description upon receipt of a tagged message, the message is processed in accordance with processes identified by tags, systems can be provided where the tagged message can additionally be processed in accordance to other predefined processing criteria specified by the recipient. In such a system, processing is performed on messages in accordance with processes identified by the tags associated with the message, and in accordance with other recipient defined processing criteria which may depend on the current requirements or context of the recipient (such as the current project being worked on) when the message is received.

In other words, tags are used by the sender to identify processes to be performed on an incoming message and process criteria, on the other hand, are specified by the recipient to identify additional processes to be performed on the incoming message. Paragraphs [0263] and [0268] teach that process criteria may be altered by the recipient continuously and that sender may also suggest changes to processing criteria, whose suggestion may be accepted or rejected. In other word, the receiver of Gross may alter what additional processes will be performed on a tagged message or even accept suggestions from the sender what additional

process should be performed on a tagged message; however, there is no teaching that the receiver of Gross would accept or reject proposed tags or categories from the receiver or proposed changes to tags or categories. The receiver of Gross retains control over tags available to the senders (see the above-quoted sentence in paragraph [0044], Gross).

The Supreme Court has recently clarified the determination of the question of obviousness. The guidance of the Supreme Court has been embodied in the guidelines for patentability in MPEP. To reject claims under 35 USC §103(a), the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP §2142. The Court held that, to find obviousness, it is necessary to resolve the Graham factual inquiries. The factual inquiries include initial determinations of the following factors:

- scope and content of the prior art

- differences between the claimed invention and the prior art

- level of ordinary skill in the pertinent art

Once the factual inquiries are resolved, the Examiner must resolve, on the basis of these factual determinations, whether the claimed invention would have been obvious to one of ordinary skill in the art. MPEP §2141. *KSR International Co.* v. *Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007).

Applicant respectfully submits that the Examiner incorrectly determined the scope and content of the prior art to the extent that the Examiner's conclusion of obviousness cannot be reasonably supported by the cited references.

Consider claim 14 first. Claim 14 requires, among others, the sender subsystem to initiate a categorization nego tiation process with the receiver subsystem, to associate the negotiated category with the message and to transmit such a categorized message to the receiver subsystem. Examiner cited paragraph [0051] (and paragraph [0026] in connection with claim 24) in an attempt to show the alleged teaching of these features. For ease of reference, these two paragraphs are reproduced below again:

> [0051] In one embodiment, the message is modified by altering, i.e, assigning a value to, recipient dependent variables in the electronic mail message. For example, this may result in a "dynamic offer"--a message that contains that contains several versions or elements that can be constructed and/or modified based on a predetermined rule set that negotiates the delivery, filtering and form of the offer based on the e-mail message's confidential "sniffing" of the recipient's private profile data 120b (by Compliance engine 154) prior to the delivery to and/or opening of such message by an intended recipient.

[0026] It is advantageous that the sender and recipient share knowledge of a common set of message type specifiers and that the mail type specifier for a given message is one selected from the common set. For example, the set may be established and/or maintained by a trusted third-party intermediary, i.e. a trusted authority.

As discussed above, Schiavone does not teach any negotiation of a category or the sender initiating such negotiation, nor associating the negotiated category with the outgoing message in these paragraphs, or anywhere in Schiavone. As further discussed above, Schiavone and Gross, either alone or in combination, also do not teach negotiation of a category initiated by the sender or the sender associating the negotiated category with the outgoing message as alleged by the Examiner. The difference between the claimed subject matter and the teaching in the prior art is therefore more than what has been alleged by the Examiner. There is no evidence nor is it alleged by the Examiner that providing a solution as claimed by Applicant, in view of the difference discussed above, would require only ordinary level of creativity of one skilled in the art. Applicant respectfully submits mere ordinary level of creativity of one skilled in the art would not be sufficient in view of the difference discussed above. It is therefore respectfully submitted that Schiavone and Gross cannot support the Examiner's conclusion of obviousness and that a prima facie case of obviousness has not been established. Accordingly, the withdrawal of rejection of claim 14 relying on Schiavone and Gross is respectfully requested.

Inasmuch as claims 15-17, 20-23 depend from claim 14 and incorporate by reference all claim limitations of claim 14, it is respectfully submitted that, at least for the reasons discussed above in connection with claim14, the Examiner's conclusion of obviousness of these claims also cannot be reasonably supported by the teachings of Schiavone and Gross. The withdrawal of rejection of claims 15-17, 20-23 is also respectfully requested.

Next, consider claim 24. Claim 24 requires, among others, a negotiation module that includes a sender subsystem that initiates negotiation of a category with the receiver subsystem and a receiver subsystem that provides an indication to the sender subsystem of its acceptance of the category and that the sender subsystem associates the negotiated category with the outgoing message. As discussed above in connection with the independent claims, negotiation of a category is not disclosed in paragraphs [0051] and [0026] of Schiavone as identified by the Examiner, nor anywhere in Schiavone. Additionally, Schiavone and Gross, either alone or in combination, also do not disclose these features. Accordingly, it is respectfully submitted that Schiavone and Gross cannot support the Examiner's conclusion of obviousness and that a

prima facie case of obviousness has not been established. Accordingly, the withdrawal of rejection of claim 24 relying on Schiavone and Gross is respectfully requested.

Inasmuch as claims 25-36 depend from claim 24 and incorporate by reference all claim limitations of claim 24, it is respectfully submitted that the Examiner's conclusion of obviousness of these claims also cannot be reasonably supported by the teachings of Schiavone and Gross. The withdrawal of rejection of claims 25-36 is also respectfully requested.

Next, consider claim 37, which requires, among others, the steps of the sender subsystem communicating a category identified by the sender to the receiver subsystem and the receiver subsystem providing an indication that the category is recognized by the receiver subsystem. As discussed above in connection with the independent claims, negotiation of a category, including the steps recited, is not disclosed in paragraphs [0051] and [0026] of Schiavone as identified by the Examiner, or anywhere in Schiavone. Additionally, Schiavone and Gross, either alone or in combination, also do not disclose these features. Accordingly, it is respectfully submitted that Schiavone and Gross cannot support the Examiner's conclusion of obviousness and that a prima facie case of obviousness has not been established. Accordingly, the withdrawal of rejection of claim 37 relying on Schiavone and Gross is respectfully requested.

Inasmuch as claims 38-43 depend from claim 37 and incorporate by reference all claim limitations of claim 37, it is respectfully submitted that the Examiner's conclusion of obviousness of these claims also cannot be reasonably supported by the teachings of Schiavone and Gross. The withdrawal of rejection of claims 38-43 is also respectfully requested.

Similarly, claim 47 requires, among others, the sender subsystem negotiating a category with the receiver and associating the category with the outgoing message only upon receiving an indication from the receiver subsystem that the category is acceptable. As discussed above in connection with the independent claims, negotiation of a category, including the steps recited, is not disclosed in paragraphs [0051] and [0026] of Schiavone as identified by the Examiner, or anywhere in Schiavone. Additionally, Schiavone and Gross, either alone or in combination, also do not disclose negotiation of a category initiated by the sender or the sender associating the negotiated category with the outgoing message. Accordingly, it is respectfully submitted that Schiavone and Gross cannot support the Examiner's conclusion of obviousness and that a prima facie case of obviousness has not been established. Accordingly, the withdrawal of rejection of claim 47 relying on Schiavone and Gross is respectfully requested.

Inasmuch as claims 48-51 depend from claim 47 and incorporate by reference all claim limitations of claim 47, it is respectfully submitted that the Examiner's conclusion of obviousness of these claims also cannot be reasonably supported by the teachings of Schiavone and Gross. The withdrawal of rejection of claims 48-51 is also respectfully requested.

Finally, consider claim 52, which requires, among others, causing the sender subsystem to initiate negotiation with the receiver to agree on a category and associating the category with the outgoing message upon receiving an indication from the receiver subsystem that the category is acceptable. As discussed above in connection with the independent claims, negotiation of a category, including the steps recited, is not disclosed in paragraphs [0051] and [0026] of Schiavone as identified by the Examiner, or anywhere in Schiavone. Additionally, Schiavone and Gross, either alone or in combination, also do not disclose the sender subsystem initiating negotiation to agree on a category or the sender associating the negotiated category with the outgoing message. Accordingly, it is respectfully submitted that Schiavone and Gross cannot support the Examiner's conclusion of obviousness and that a prima facie case of obviousness has not been established. Accordingly, the withdrawal of rejection of claim 52 relying on Schiavone and Gross is respectfully requested.

Inasmuch as claims 53-56 depend from claim 52 and incorporate by reference all claim limitations of claim 52, it is respectfully submitted that the Examiner's conclusion of obviousness of these claims also cannot be reasonably supported by the teachings of Schiavone and Gross. The withdrawal of rejection of claims 53-56 is also respectfully requested.

(b) Claims 18, 19, and 44-46

The Examiner rejected claims 18, 19, and 44-46 under 35 USC §103(a) as being obvious over Schiavone and Gross, in view of Koenig (U.S. Patent Application Publication No. 2002/0120748).

As discussed above in connection with claim 14, Schiavone and Gross, either alone or in combination, do not teach each and every claim limitations of claim 14. At least Koenig also does not teach at least negotiation of a category. Koenig describes a method and system for selective delivery and forwarding of electronic mail. Like in Schiavone, selection criteria are pre-established by recipient. The selection criteria determine how an incoming e-mail message will be delivered and routed (Abstract, Koenig). However, Koenig does not teach any negotiation of a category between a sender subsystem and the recipient system. Therefore, Schiavone,

Gross and Koenig, even in combination, also do not teach each and every claim limitations of claim 14.

Claims 18 and 19 depend from claim 14 and incorporate by reference all claim limitations of claim 14. For at least the same reasons discussed above in connection with claim 14, it is respectfully submitted that the Examiner's conclusion of obviousness cannot be supported by the cited references, namely Schiavone, Gross and Koenig, and that a prima facie case of obviousness has not established. The withdrawal of rejection of claims 18 and 19 is respectfully requested.

Claims 44-46 depend from claim 37 and incorporate by reference all claim limitations of claim 37. As discussed above in connection with claim 37, Schiavone and Gross, either alone or in combination, do not teach each and every claim limitations of claim 37. As discussed above, Koenig also does not teach any negotiation of a category. Therefore, Schiavone, Gross and Koenig, even in combination, also do not teach each and every claim limitations of claim 37.
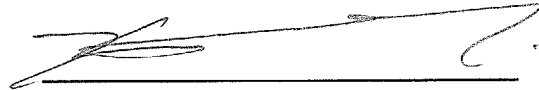
For at least the same reasons discussed above in connection with claim 37, it is respectfully submitted that the Examiner's conclusion of obviousness cannot be supported by the cited references, namely Schiavone, Gross and Koenig, and that a prima facie case of obviousness has not established. The withdrawal of rejection of claims 44-46 is respectfully requested.

In view of the foregoing, the Applicant respectfully submits that claims 14 to 56, as amended, are all novel, non-obvious and are all allowable over the references cited. The Applicant respectfully requests the reconsideration of the rejections of these claims and allowance of the present application.

The Examiner is invited to contact the undersigned by telephone to discuss this case further, if necessary, at (416) 863-5839.

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